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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

HWANG, VICTOR KENNY

ART UNIT	PAPER NUMBER
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3764

DATE MAILED: 03/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/880,554

Applicant(s)

BATCA ET AL.

Examiner

Victor K. Hwang

Art Unit

3764

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 November 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,5-8,11-13 and 19 is/are rejected.
- 7) ☒ Claim(s) 3,4,9,10 and 14-18 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 November 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.

JEROME W. DONNELLY
PRIMARY EXAMINER

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on November 08, 2004 has been entered.

Response to Declaration

2. The declaration filed on November 08, 2004 presumed to be under 37 CFR 1.131 has been considered but is ineffective to overcome the *O'Hearn* (US Pat. 6,565,490 B2) reference.

The *O'Hearn* reference is a U.S. patent or U.S. patent application publication of a pending or patented application that claims the rejected invention. An affidavit or declaration is inappropriate under 37 CFR 1.131(a) when the reference is claiming the same patentable invention, see MPEP § 2306. If the reference and this application are not commonly owned, the reference can only be overcome by establishing priority of invention through interference proceedings. See MPEP Chapter 2300 for information on initiating interference proceedings. If the reference and this application are commonly owned, the reference may be disqualified as prior art by an affidavit or declaration under 37 CFR 1.130. See MPEP § 718.

Allowable Subject Matter

3. The indicated allowability of claim 13 is withdrawn in view of the newly discovered reference(s) to *Gifford et al.* (US Pat. 232,022). Rejections based on the newly cited reference(s) follow.

4. Claims 3, 4, 9, 10 and 14-18 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Drawings

5. New corrected drawings in compliance with 37 CFR 1.121(d) are required in this application because the drawings received Nov. 08, 2004 are only marked-up copies. Applicant is advised to employ the services of a competent patent draftsman outside the Office, as the U.S. Patent and Trademark Office no longer prepares new drawings. The corrected drawings are required in reply to the Office action to avoid abandonment of the application. The requirement for corrected drawings will not be held in abeyance.

Claim Objections

6. Claim 6 objected to because of the following informalities: on line 5, "first" presumably should be changed to --second--. Appropriate correction is required.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 1, 2, 5-8 and 11 are rejected under 35 U.S.C. 102(e) as being anticipated by *O'Hearn* (US Pat. 6,565,490 B2). *O'Hearn* discloses an exercise machine comprising a frame structure 14; a weight stack load 34 supported by the frame structure; first and second pull handles 65,72; a dual sliding pulley assembly connected to the pull handles including first and second linearly movable pulleys 58,64 that can be adjusted to a desired position by a user independently of one another; and a shared connecting cable 52 connecting the dual sliding pulley assembly to the load so that either of the pull handles can be used to lift the load. The dual sliding pulley assembly further comprises a first and second sliding carriages 26 carrying the first and second movable pulleys, each sliding carriage mounted on a respective column so as to be vertically adjustable; first and second floating pulleys 51,70; a first cable 46 or 48 connected at one end to the first sliding carriage and at the opposite end to the pull handle, the first cable passing around the first movable pulley and the first floating pulley; a second cable 46 or 48 connected at one end to the second sliding carriage and at the opposite end to the second pull handle, the second cable passing around the second movable pulley and the second

floating pulley; and a third cable 50 connected at opposite ends to the first and second pulleys. The shared connecting cable 50 supports a third floating pulley 76 at one end, passes around a movable pulley 80 secured to the load, and terminates at a third force applying member 88.

9. Claims 12, 13 and 19 are rejected under 35 U.S.C. 102(b) as being anticipated by *Gifford* (US Pat. 232,022). *Gifford* discloses an exercise machine comprising a frame structure *E*; a load *L* supported by the frame structure; at least one force applying member *x*; a cable and pulley system connecting the force applying member to the load; a bench *C* detached from the frame structure to support a user; and an adjustable brace *M* connected to the frame structure and movable between at least first and second positions, the brace functioning as a stop member to prevent the bench from sliding during a first exercise (Fig. 4), and functioning as a foot rest for the user during a second exercise (Fig. 1). There are two independently adjustable force applying members *x*. The force applying members comprise pull handles.

10. Claims 1, 5-7 and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by *Davis* (US Pat. 5,842,961). *Davis* discloses an exercise machine comprising a load 52; first and second pull handles 210; a dual sliding pulley assembly connected to the pull handles, the dual sliding pulley assembly including first and second linearly movable pulleys 100,140 that can be adjusted to a desired position by the user independently on one another; and a connecting cable 190 connecting the dual sliding pulley assembly to the load so that use of either one or both of the force applying members lifts the load. The first and second moveable pulleys are slidably mounted on respective columns 134,80 so as to be vertically adjustable.

11. Claims 12 and 19 are rejected under 35 U.S.C. 102(b) as being anticipated by *Webber et al.* (US Pat. 5,807,219). *Webber et al.* discloses an exercise machine comprising a frame structure 16 ; a load 22 supported by the frame structure; at least one force applying member comprising first and second pull handles 26,73; a cable and pulley system 25 connecting the force applying members to the load; a bench 71 detached from the frame structure to support a user; and an adjustable brace 58 connected to the frame structure and movable between at least first and second positions. The brace may be used as a stop member to prevent the bench from sliding during a first exercise and as a foot rest for the user during a second exercise.

Response to Arguments

12. Applicant's arguments, see pg. 9 of the Remarks filed November 08, 2004, with respect to *Fitzpatrick* have been fully considered and are persuasive. The rejection of claims 1, 5-7 and 11 as being anticipated by *Fitzpatrick* has been withdrawn.

In response to applicant's argument that *Webber et al.* does not show the roller pad 58 functioning as a roller pad in any position, pg. 10 of the Remarks filed Nov. 08, 2004, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 312 F.2d 937, 939, 136 USPQ 458, 459

(CCPA 1963). In this instance, the roller pad is capable of use as a foot rest for the user during a second exercise.

In response to Applicant's arguments that the Declaration of Ron Batca, pg. 10 of Remarks filed November 08, 2004, removes *O'Hearn* as a reference, the Examiner disagrees. Presumably, the declaration filed November 08, 2004 is a Declaration Under 37 CFR 1.131. As noted above, Applicant and *O'Hearn* are claiming the same invention. Applicant's Declaration states that the claimed invention, a prototype, was constructed concurrently with the design of the invention. Only one drawing sketch appears to have a date (Smith Bar Hook dated 2-07-01, two days prior to the effective date of the *O'Hearn* reference) and the Examiner questions why only one drawing sketch would have a date and none of the others.

The declarant states that the prototype was conceived, constructed and tested prior to February 9, 2001 and that the elements of claims 1 and 6 were included in the prototype. There is no mention of the elements of claims 2, 5, 7, 8 and 11. From the photographs, it is difficult to see whether the first and second floating pulleys (claims 2 and 8) are included in the prototype. The sketches (see sketch showing pulley and cable configuration) do appear to show the first and second floating pulleys. Considering the evidence presented in the Declaration in its entirety, Applicant has established to the Examiner's satisfaction that the invention was reduced to practice prior to the effective date of the *O'Hearn* reference.

Conclusion

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Bossert (DE 198 01 672 A1) discloses an exercise machine reading upon claims 1, 5-7 and 11.


Trainor (US Pat. 6,592,498 B1) and *Alessandri et al.* (EP 1 402 925 A1) disclose similar cable and pulley arrangements.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor K. Hwang whose telephone number is (571) 272-4976. The examiner can normally be reached Monday through Friday from 7:30 AM to 4:00 PM Eastern time.

The facsimile number for submitting papers directly to the examiner for informal correspondence is (571) 273-4976. The facsimile number for submitting all formal correspondence at this time is (703) 872-9306.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory L. Huson can be reached on (571) 272-4887.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


JEROME W. DONNELLY
PRIMARY EXAMINER

Victor K. Hwang
February 27, 2005